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APR 02 2004

OFFICE OF PETITIONS

In re Application of :
Yang and Chih :
Application No. 10/734,229 : DECISION REFUSING STATUS
Filed: 15 December, 2003 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 3319-0110P :

This is in response to the petition filed under 37 CFR 1.47(a)¹
on 15 December, 2003.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of
this decision to reply, correcting the below-noted deficiencies.
Any reply should be entitled "Request for Reconsideration of
Petition Under 37 CFR 1.47(a)," and should only address the
deficiencies noted below, except that the reply may include an
oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR
1.136(a).

The above-identified application was filed on 15 December, 2003,
with a declaration naming Pang-Lun Yang and Ting-Hui Chih as
joint inventors and signed by joint inventor Chih on behalf of
himself and joint inventor Yang. The present petition was also
filed on 15 December, 2003.

Petitioners assert that the non-signing inventor was contacted by
telephone and refused to sign the declaration. Petitioners
further assert that the non-signing inventor requested that the
application papers not be sent to him.

¹ A petition under 37 CFR 1.47(b) is inappropriate in this instance since all but
one of the inventors has signed the declaration. A petition under 37 CFR 1.47(b) is
only appropriate where none of the inventors will sign. Accordingly, the petition
will be treated as a petition under 37 CFR 1.47(a).

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort; or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1).

In regards to item (1), petitioners have not provided proof that Yang was ever sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).² It is noted that the declaration of Yu-Hui Sung states that the non-signing inventor requested that the application papers not be sent to him. Notwithstanding Sung's declaration, however, in order for a Rule 47 petition to be granted, the inventor **must** be afforded an opportunity to review the application.³ Therefore, petitioners should send a copy of the application papers to Yang's last known address. Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a

²MPEP 409.03(d).

³See In re Gray, 115 USPQ 80 (Comm'r Pat. 1956). The application papers must be sent or given to the non-signing inventor unless he or she refuses to accept delivery of the papers.